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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/160,635	09/24/1998	VERNON WONG	A-60179-2/DJ	6584

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EXAMINER

WEBMAN, EDWARD J

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 12/04/2003

31

Please find below and/or attached an Office communication concerning this application or proceeding.

Art Unit: 1617

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10, 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Dennis et al.

Dennis et al. Teach a powder containing an active comprising up to 45% alginic acid and up to 35% gelling agent (abstract). Hydroxypropylmethyl cellulose is disclosed (column 5 line 31). Up to 57% active is specified (column 4 lines 17-19).

Applicants argue that Dennis et al do not teach an implant. However, applicants claim a particle and Dennis et al teaches such, "IMPLANT" is merely an intended use. As to "Biodegradable polymer", alginic acid is such a polymer, reading also on "degraded". As to the claimed dosage variation, such is a property that must be possessed by the Dennis et al composition because it is the same as that claimed.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 34-40, 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Bernstein et al.

Art Unit: 1617

Bernstein et al teaches soluble cationic release modifiers in matrices of biocompatible polymers (abstract, column 5 lines 27-35). Polylactide glycoside is disclosed (column 3, line 62). 20-30% modifier is disclosed (column 5 lines 10-12). Steroids are specified (column 4 line 34). Up to 50% active is disclosed (column 4 line 51). Biodegradable polymers are specified (column 3 line 56). Microspheres are disclosed (column 12 line 8).

Applicants argued that Bernstein et al do not teach the claimed site of implantation and sizing. However, These are mere intended uses. The examiner notes that Gombotz et al is used to make the particles of Bernstein et al (see column 12 lines 145-15). Gombotz et al. Teach particles as small as 5 microns (column 5 lines 44-51), within the broad range of 2 microns to 3 millimeters disclosed by applicants (page 12 lines 20-21).

Applicants are correct ^{at} the claim 21 is not pending. However, claims 41, 42 have been withdrawn from consideration because they are directed to non-elected structures. See paper #7, filed 2/22/02.

Claims 10, 13, 34-40, 43 are rejected.

Claims 15-18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 19, 20, 22-25, 28, 29 are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 1617

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Webman whose telephone number is (703) 308-4432. The examiner can normally be reached on Monday to Friday 9 Am 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Padmanabhan can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Webman/LR
October 30, 2003

EDWARD J. WEBMAN
PRIMARY EXAMINER
GROUP 1500